

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Gregory Povolny et al.

Serial No. 09/306,790

Filed: May 7, 1999

Attorney Docket No. 068223/0122

Group Art Unit: 2777

Examiner: Not assigned yet

For: FILE TRANSFER SYSTEM AND METHOD

**INFORMATION DISCLOSURE STATEMENT
UNDER 37 CFR §1.56 and 37 CFR §1.97(b)**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Submitted herewith on a modified Form PTO-1449 is a listing of documents known to applicant in order to comply with applicant's duty of disclosure pursuant to 37 CFR §1.56. A copy of each listed document is being submitted to comply with the provisions of 37 CFR §1.97-1.98.

The submission of any documents herewith, which is not a statutory bar, is not intended as an admission that such documents constitute prior art against the claims of the present application or that such documents are considered material to patentability as defined in 37 CFR §1.56(b). Applicant does not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any document which is determined to be a prima facie prior art reference against the claims of the present application.

TIMING OF THE DISCLOSURE AND FEE

The instant Information Disclosure Statement is being submitted in compliance with 37 C.F.R. §1.97(b), before the mailing date of a first Office action on the merits. No fee is believed to be necessary; however, if counsel is mistaken, the Commissioner is hereby

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authorized to charge any deficiency or to credit any overpayment to Deposit Account No. 19-0741.

EXPLANATION OF RELEVANCE OF EACH DOCUMENT

The listed documents are possibly relevant based on the Supreme Court decision in *Pfaff v. Wells Electronics, Inc.*, 119 S.Ct. 304, relating to an on-sale bar. Under *Pfaff*, an on-sale bar applies when two conditions are satisfied more than one year before the filing date of the application. The first condition is that the product must be the subject of a commercial offer for sale. The second condition is that the invention must be ready for patenting. The second condition can be satisfied in either of two ways: by proof of reduction to practice before the critical date; or by proof that prior to the critical date, the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.

Document A1 is a "Statement of Work", which refers to an FTF/MQ version 2. The FTF/MQ version 2 relates to a software system that is the subject of the present application. Although this "Statement of Work" refers to an installation of FTF/MQ Version 2 in April of 1998 (see section 3.2.1.b.), the product was not actually delivered until June 30, 1998. Document A2 is a copy of a shipping receipt dated June 30, 1998, which corresponds to the date that the FTF/MQ Version 2 was delivered to Charming Shoppes per the "Statement of Work".

Although reduction to practice does not require delivery to a customer, the delivery date of June 30 does establish a date by which reduction to practice was achieved. Applicants submit, however, that there was no reduction to practice of the FTF/MQ Version 2 prior to May 7, 1998, which is the filing date of the present application. Accordingly, there is no on-sale bar based upon an offer for sale and reduction to practice more than one year before the filing date of the present application.

Document A3, entitled "Messaging Architecture Requirements and Discussion", provides a high level description and high level drawings of expected components and procedures for FTF/MQ Version 2. Document A4, although undated, provides a similar

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high level description and drawing as that provided in Document A3. Applicants submit that the descriptions and drawings provided in Documents A3 and A4 are not sufficiently specific to enable a person skilled in the art to practice the invention as claimed.

Applicants further submit that, to the best of their knowledge and belief, they had not prepared any other drawings or descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention prior to May 7, 1998.

Therefore, there is also no on-sale bar based upon an offer for sale and prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention more than one year prior to the filing date of the present application

Applicants therefore submit that the present application is not subject to an on-sale bar.

In addition, even if documents A1-A4 were applied as prior art against this application, these documents, whether taken singly or in combination, fail to anticipate or render obvious any of the pending claims. Only the independent claims will be discussed below.

With respect to independent claims 1 and 13, none of these documents discloses or suggests establishing at least two logical channels between first and second locations.

With respect to independent claims 25 and 31, none of these documents discloses or suggests that the generated markers are accessible to a computer system located at the source location and a computer system located at the target location.

With respect to independent claims 30 and 36, none of these documents discloses or suggests that the file is stored only in the memory at the source location during the file transfer.

With respect to independent claims 37 and 42, none of these documents discloses or suggests a requesting computer or a managing computer separate from a source computer.


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With respect to independent claims 47 and 49, none of these documents discloses or suggests transmitting at least a first portion of a file asynchronously from a transmission of a second portion of the file.

Applicants respectfully request that the listed documents be considered by the Examiner and formally be made of record in the present application and that an initialled copy of Form PTO-1449 be returned in accordance with MPEP §609.

Respectfully submitted,

October 19, 1999
Date

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